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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,077	02/26/2004	Masayuki Nakagiri	1982-0209P	3543
2292	7590	09/06/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			SIPOS, JOHN	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	
			3721	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/786,077

Applicant(s)

NAKAGIRI ET AL.

Examiner

John Sipos

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2006 and 24 April 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 7-19 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

**DETAILED ACTION**

***MISCELLANEOUS***

The supplemental reply filed on June 21, 2006 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The supplemental reply is clearly not limited to placement of the application in condition for allowance. (see MPEP section 714.03(a)).

The last amendment that was entered was the Amendment of April 24, 2006 on which the following action is based.

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***RESTRICTION REQUIREMENT***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Group I. Claims 1-6**, drawn to a sheet processing apparatus, classified in Class 53, subclass 520.

**Group II. Claims 7-19 and 21**, drawn to a sheet processing apparatus with a specific stacking operation, classified in Class 53, subclass 540.

The inventions are distinct, each from the other, because of the following reasons:

The inventions of Groups I and II are related as **subcombinations disclosed as useable together in a single combination**. The subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, the invention of Group I has separate utility because it can be used in a packaging machine without the specific stacking structure recited in the claims of Group II. (See MPEP 806.05(d)).

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It should be noted that claim 21 (which was indicated as allowable upon the cancellation of claim 1) provides evidence that it require the particulars of the stacking operation for its patentability. Even if other claims *do* set forth these particulars, distinction between the *inventions* is shown if one subcombination claim does not include the particulars of the other subcombination claim. The presence of the particulars in the dependent claims indicates that they *may be* included as part of the combination, but the claims selected above provide evidence that the particulars are not *required*. (See MPEP 806.05(c), Example 3.)

Because these inventions are distinct for the reasons given above, and because they have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes, as indicated, is proper.

Following is 37 CFR 1.145 which concerns the constructive election of an invention which has previously received an Office action:

"If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in 1.143 and 1.144."

Newly presented claims 7-19 and 21 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention of Group I, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-19 and 21 are

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withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

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***REJECTIONS OF CLAIMS BASED ON PRIOR ART***

**Claims 1, 2 and 6** are rejected under **35 U.S.C. 102(b)** as being anticipated by the patent to Ishii (6,907,711). The patent to Ishii shows a sheet processing apparatus comprising a longitudinal slitting apparatus 2, a transverse chopping apparatus 16, a stacking apparatus at 17, a transport apparatus 30,34 that spaces the stacks, a cover applying apparatus 31 and a packing apparatus 5. The "guide channels" are read on elements 27a,b,c. The change of direction of Claim 6 is shown at the end of the production line at 82.

**Claim 1** is rejected under **35 U.S.C. 103(a)** as being unpatentable over the patent to Muylle (4,480,742). The patent to Muylle shows a sheet processing apparatus comprising a longitudinal slitting apparatus 37, a transverse chopping apparatus 39, a stacking apparatus at 44, a transport apparatus 41/42 and a packing apparatus (column 5, lines 21-25).

The use of guide channels in conveying articles is well known in the art and the Examiner takes official notice that their use is common knowledge in the packaging art. It would have been obvious to one skilled in the art to provide the Hoffman operation with guide channels to ensure proper conveyance of the articles.

**Claims 2-4** are rejected under **35 U.S.C. 103(a)** as being unpatentable over the patent to Muylle (4,480,742) or Ishii (6,907,711) in view of Ballestrazi (European

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Application 819,637). The Muylle reference lacks the showing of a stack inversion apparatus and a cover sheet application apparatus. The Ballestrazi reference shows a sheet/magazine handling device which comprises at least two cover sheet application devices 12,12',12'' and an intermediate gripping mechanism 25 that inverts the stack of sheets so that the cover sheets are placed on different sides of the stack. It would have been obvious to one skilled in the art to provide the Muylle or Ishii devices with cover applying devices and intermediate inverting mechanisms so that the sheets can be applied on different sides of the stack as shown by Ballestrazi.

**Claim 5** is rejected under **35 U.S.C. 103(a)** as being unpatentable over the patent to Muylle (4,480,742) or Ishii (6,907,711) in view of Ballestrazi (European Application 819,637) as applied to the claims above, and further in view of the patent to Kwasnitza (German patent 3,703,951). The modified Muylee or Ishii devices do not show an inverter gripping mechanism rotating about an axis intersecting the direction of movement of the stacks. The Kwasnitza patent shows an inverting mechanism 1 that grips a stack of sheets and rotates about an axis perpendicular to the transport direction (See Figure 2) thereby positively gripping the stack during the manipulation of the stack. It would have been obvious to one skilled in the art to substitute the inverting mechanism of Kwasnitza for the inverting mechanism of the modified Muylee or Ishii devices to positively maintain control of and grip the stack throughout its inversion.

**Claims 6** is rejected under **35 U.S.C. 103(a)** as being unpatentable over the patent to Muylle (4,480,742) in view of Ballestrazi (European Application 819,637) as applied to the claims above, and further in view of the patent to Uno (5,507,615) or

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Maeda (5,365,817). The Muylee devices lacks the showing of transfer section in the transport devices that change the direction of movement of the stacks. The patents to Uno and Maeda shows the longitudinal and transverse cutting of sheets to form stacks and transporting the sheets by a transfer section that changes the direction of movement of the sheets without altering their orientation in this manner reducing the size/length of the transport line. It would have been obvious to one skilled in the art to provide the transport section of Muylee with a section for changing the direction of the sheets as shown by Uno or Maeda to reduce the size/length of the apparatus.

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### ***RESPONSE TO APPLICANT'S ARGUMENTS***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. However, it should be noted that the patent to Muylle discloses in column 5, line 13 et seq that the conveyor belt 43 is stopped to receive and stack the sheets into stacks 44 and then energized to rapidly transfer the stacks to the packaging station. This stop and go operation would inherently space the stacks from each other.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4668**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for U.S. Patent and Trademark Office is **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

Stephen F. Gerrity  
Primary Examiner

  
John Sipos  
Primary Examiner  
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